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APPLICATION NO.	FILED DATE	DESIGNATED INVENTOR	EXAMINER FOR FILED DATE	CO-EXAMINER
09-457,765	12/10/1999	HAROLD M. MOODY	PAMELA S. COOPER	SOLO

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EXAMINER

MELLER, MICHAEL V

ARTICLE	PAPER NUMBER
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DATE MAILED	08/09/2002	75
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/457,765	MOODY ET AL.
	Examiner	Art Unit
	Michael V. Meller	1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply, be timely filed, after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply, within the statutory minimum of thirty (30) days will be considered timely;
- If NO period for reply is specified above, the maximum statutory period will apply, and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 May 2002.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8 and 11-13 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.

- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 fails to further limit claim 1. It is confusing how claim 11 further limits claim 1.

Claim Rejections - 35 USC § 103

Claims 1-8 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 92/01061 ('061) taken with WO 95/03420 ('420) for the reasons of record and for the reasons which follow.

Applicant has argued that the amounts of 6-APA, ampicillin and phenyl glycine derivative are not the same as '061. The examiner on page 4 of the last Office action mailed 11/23/2001, paper number 13 very clearly explained the exact reasons why the references met the claimed invention. Applicant has produced tables comparing the

applicant's examples with that of '061. While these tables are noted, it is also noted that applicant has not looked at '061 as a whole. Applicant has disregarded the overall disclosure of '061 and the claims. As very clearly explained in the previous Office action, the claims are met by '061. While applicant may have analyzed the specific examples of both the instant invention and that of '061, the specific examples of '061 and the entire disclosure of '061 need to be considered which applicant has not done. For the reasons of record it would have been clearly obvious to perform the claimed process.

Next, applicant presents claims which claim that the concentrations of 6-APA and ampicillin are kept at the concentrations throughout the reaction. It would be assumed that such concentrations are inherently present throughout the reaction since a certain amount of 6-APA or ampicillin was put in at the beginning of the reaction and there is no reason to believe that the same amount of 6-APA or ampicillin would not also be present throughout the reaction.

With regard to applicants arguments concerning '420 this reference was not cited to show each and every aspect of the claimed invention. Further, it was not relied upon as the main reference in the rejection only for what is of record, to teach the use of D-phenylglycine amide. $1/2 \text{H}_2\text{S O}_4$ in water. Also, it is noted that '420 does not teach what applicant says it does, namely that it allegedly teaches that the concentrations of reactants used by the process are not critical.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Without more, the references form a proper 35 USC 103 rejection.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V. Meller whose telephone number is 703-308-4230. The examiner can normally be reached on Monday thru Friday: 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 703-308-4743. The fax phone

numbers for the organization where this application or proceeding is assigned are 703-308-0294 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Michael V. Meller
Examiner
Art Unit 1651

MVM
August 8, 2002